



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/595,202

05/11/2006

Thomas Hafker

Q93831

4549

23373 7590 11/20/2008
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

GERRITY, STEPHEN FRANCIS

ART UNIT

PAPER NUMBER

3721

MAIL DATE

DELIVERY MODE

11/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,202	Applicant(s) HAFKER ET AL.	
	Examiner Stephen F. Gerrity	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/23/06, 4/20/06, 5/30/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of the invention of Group II (claims 6-17) in the reply filed on 10 September 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 1-5 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10 September 2008.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

4. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. § 119. The certified copy has been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

Information Disclosure Statement

5. Receipt is acknowledged of Information Disclosure Statements, filed 23 March 2006, 20 April 2006 and 30 May 2008, which have been placed of record in the file. An

Art Unit: 3721

initialed, signed and dated copy of each of the PTO-1449 forms is attached to this Office action.

Drawings

6. The replacement sheets of drawings were received on 6 June 2006. These drawings are acceptable.

7. The drawings filed 23 March 2006 are objected to because:

- in figures 9-12 the reference label “11” is incorrect and should be changed to --67--; and
- in figure 9, the reference label “12” is incorrect and should be changed to --67--.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

Art Unit: 3721

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

8. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title of the invention should be amended so that it is consistent with the claimed invention, and it is suggested that a description of an element of applicant's claimed invention which is considered a feature of novelty be added to the title of the invention.

9. The abstract of the disclosure is objected to because of the use of legal phraseology, i.e. means, in line 5. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 6-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly

Art Unit: 3721

and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

The following are examples of the vague and indefinite language found throughout the claims, applicant is required to review and revise all of the claims in order to ensure their compliance with 35 USC 112, 2nd paragraph:

claim 6, line 1, the parenthetical term “(cigarette)” renders the claim language vague and indefinite as it is unclear if the term is to be given patentable weight;

claim 6, lines 2 and 3, the expression “in particular a coupon which has been folded a number of times” renders the claim indefinite because it is unclear whether the limitation following the phrase “in particular” is part of the claimed invention -- see MPEP § 2173.05(d);

claim 6, line 3, the expression “it being possible ...” renders the claim vague and indefinite because the language is ambiguous;

claim 6, line 3, “blank or coupon” renders the claim vague and indefinite because it is unclear from the claim language as to the particular article for which applicant seeks patent protection;

claim 6, lines 3 and 4, “in particular a magazine” renders the claim vague and indefinite;

claim 6, line 4, the expression “in the region” is vague, as the claim language is not precise and fails to particularly point out the structure of the invention;

claim 6, line 4, "a packaging machine - packer -" renders the claim vague and indefinite because it is unclear if the packer is part of the claimed structure for which applicant seeks patent protection;

claim 6, line 6, "blanks or coupons" renders the claim vague and indefinite;

claim 6, line 4, the expression "in the region" is vague, as the claim language is not precise and fails to particularly point out the structure of the invention;

claim 6, lines 6 and 7, it is unclear if the term "coupon arrangement" is meant to define a structural element or a functional element, thus rendering the claim language vague and indefinite;

claim 6, line 10, the expression "namely upright magazines" renders the claim vague and indefinite because it is unclear if the limitation following the term "namely" is part of the claimed invention;

claim 6, line 10, the expression "in the region" is vague, as the claim language is not precise and fails to particularly point out the structure of the invention;

claim 6, line 11, the expression "it being possible ..." renders the claim vague and indefinite because the language is ambiguous;

claim 6, line 12, "which are open at the top" is vague and indefinite because it is unclear precisely what is open at the top;

claim 6, line 14, the expression "can be set down on a conveyor" is vague and indefinite because the structure which performs the function of setting down has not been positively set forth in the claim; and

claim 6, lines 14 and 15, "in particular on a transporting cart" renders the claim vague and indefinite.

These are examples of the language in the claims 6-17 which renders all of the claims vague and indefinite. Applicant is respectfully requested to review and revise all of the claims. The claims should be corrected so that the claims may particularly point out and distinctly claim the subject matter which applicant regards as the invention, as required by 35 U.S.C. § 112, second paragraph.

Allowable Subject Matter

12. Claims 6-17 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references listed on the attached form (PTO-892) are cited to show stacking of articles in containers, feeding of articles, and cigarette packing machines. All are cited as being of interest and to show the state of the prior art.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen F. Gerrity whose telephone number is 571-272-4460. The examiner can normally be reached on Monday - Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen F. Gerrity/
Primary Examiner, Art Unit 3721

18 November 2008